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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/758,908

01/16/2004

Felix Capanni

60,500-114

7057

27305

7590

09/29/2006

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EXAMINER

GEHMAN, BRYON P

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/758,908

Applicant(s)

CAPANNI ET AL.

Examiner

Bryon P. Gehman

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3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,10,12-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,10,12-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. The additional drawing of Figure 3A was received on August 11, 2006. This drawing is unacceptable, as it includes new matter in composition of the second plate 12a.

2. The amendment filed August 11, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: That the second plate has apertures therethrough and non-apertured portions each engaging the tips of the screws as shown in the new Figure. That the second plate engages heads or tips, as opposed to any other part of the screws.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 10 is finally rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the existence of a second plate, does not reasonably provide enablement for what this comprises in the context of the claimed invention, as the detailed description fails to indicate what this mentioned plate consists of. The original specification does not enable any person skilled in the art to which it

pertains or with which it is most nearly connected, to provide the invention commensurate in scope with these claims. The second plate, while originally mentioned, is not explained in sufficient detail in the specification nor shown in the drawings to enable one of ordinary skill in the art to provide the second plate, or enable its provision in the claimed device.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 4-7, 12-15 and 17-20 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Happonen et al. (7007,798) in view of Sundstrom (6,974,030). Happonen et al. discloses a system for keeping ready bone screws comprising a device (1) capable of receiving bone screws, the device having a surface (top of 4) and plate (4) with a plurality of orifices (2) for inserting the bone screws, the device allowing inserted bone screws to be kept countersunk in relation to the surface (see Figure 1b), and a removal instrument (13) for removing a bone screw from the device, the removal instrument dimensioned so that it is insertable into one of the orifices to remove a bone screw (see Figure 1b), and the device able to receive bone screws of different sizes and shapes (see column 2, lines 62-67 and column 3, lines 34-37), the orifices aligned in a row. Sundstrom discloses a screw-holding device (1) having orifices arranged in a

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plurality of rows to hold numerous screws. To modify the device of Happonen et al. employing the orifices in a plurality of rows would have been obvious in order to provide more orifices for more screws, as suggested by Sundstrom. The claimed device is not claimed to actually include bone screws per se. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As to claims 2, 5, 17 and 20, Happonen et al. disclose each orifice dimensioned to guide the removal instrument into the orifice.

As to claims 6 and 7, Happonen et al. disclose pocket holes with contained screws lying on the bottom of the pocket holes (the pocket holes extending as far as the engagement of the bottom of the screw head with the orifice).

As to claims 12-15, 18 and 20, Happonen et al. disclose the delimitation walls of the orifices reduced in diameter below the surface, the reduction in diameter being gradually decreasing continuously or in steps, the reduction in inner diameter acting as a stop for the heads of a contained screw.

7. Claims 1-2, 4-7, 12-15 and 17-20 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Latulippe et al. (5,394,983) in view of Happonen et al..

Latulippe et al. disclose a system for keeping ready bone screws comprising a device (11) capable of receiving bone screws, the device having a surface (top of 11) and plate (11) with a plurality of orifices (15A) as part of the plate (11) for inserting the bone screws, the orifices arranged in the surface in a plurality of rows. Happonen et al. disclose a device provided with orifices to receive screws and allowing inserted bone screws to be kept countersunk in relation to the surface (see Figure 1b), and a removal instrument (13; 41; 109 and 110) for removing a bone screw from the device, the removal instrument dimensioned so that it is insertable into one of the orifices to remove a bone screw (see Figure 1b). To modify the orifices of Latulippe et al. employing the internal structure of Happonen et al. would have been obvious in order to gain the advantages of the orifices as disclosed by Happonen et al. in the overall device.

As to claims 2, 5, 17 and 20, Happonen et al. disclose each orifice dimensioned to guide the removal instrument into the orifice.

As to claims 6 and 7, Happonen et al. disclose pocket holes with contained screws lying on the bottom of the pocket holes (the pocket holes extending as far as the engagement of the bottom of the screw head with the orifice).

As to claims 12-15 and 18-20, Happonen et al. disclose the delimitation walls of the orifices reduced in diameter below the surface, the reduction in diameter being gradually decreasing continuously or in steps, the reduction in inner diameter acting as a stop for the heads of a contained screw.

8. Applicant's arguments with respect to claims 1-2, 4-7, 10, 12-15 and 17-20 have been considered but are moot in view of the new ground(s) of rejection. The second plate is maintained to be too vaguely mentioned in the original disclosure so as to enable one of ordinary skill in the to provide the same in the claimed combination, much less how now proposes amending the specification and drawings to represent this second plate. To dispose a plurality of screw-receiving orifices in a plurality of rows would have been obvious modification in combination with Happonen et al., either as a base reference or a secondary reference as now employed.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Roeder discloses spaced plates of a screw-holding device. . .

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Monday through Wednesday from 5:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bryon P. Gehman  
Primary Examiner  
Art Unit 3728

BPG